

Remarks

Claims 1, 3-8, 10-15, 17-21 and 23-32 currently stand rejected and remain pending. Claims 3, 10 and 17 have been amended. The Assignee respectfully traverses the rejections and requests allowance of claims 1, 3-8, 10-15, 17-21 and 23-32. The Assignee respectfully traverses the rejections in view of the following discussion.

Claim Rejections under 35 U.S.C. § 101

Claims 1, 3 – 7 and 24 – 26 stand rejected under 35 U.S.C. § 101 because the claimed subject matter is directed to non-statutory subject matter. The examiner alleges that the claimed subject matter in the instant application fails to define a result in the process that is being claimed. Therefore the examiner further alleges that the claims fail to provide a practical application that produces a useful, tangible and concrete result.

Claim 1 is for a method of operating a service control point. It is well known in the arts that service control points (SCP) receive call-setup messages. The SCP uses the information in the call-setup message to determine routing instructions for the call. Once the proper routing instructions have been determined the SCP then returns the proper routing instructions. Claim 1 is a new method for operating a service control point to determine the proper routing instructions for a call. The new method includes identify a first device where the first device is a wireless device, sending an alert message to the first device, receiving a response message from the first device that identifies a second device, and generate routing instructions that connect the incoming call to the second device. Once the routing instructions have been determined the routing instructions are returned.

Practical utility is a shorthand way of attributing "real-world" value to claimed subject matter. In other words, one skilled in the art can use a claimed discovery in a manner which provides some immediate benefit to the public. *Nelson v. Bowler*, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980). Here, one skilled in the arts can use the claimed invention to provide an immediate benefit to the public. Using a SCP to re-route an incoming call from a first device to a second device provides a useful, tangible and concrete result. Without this invention, an

incoming call to a device that does not have the capacity to complete the call will be unsuccessful. For example, an incoming fax call to a cell phone will not be completed successfully. Using the invention of claim 1, the proper routing instructions will be transmitted from the SCP such that the incoming fax call will be re-routed to a device that can handle the call. Therefore claim 1 has utility and is allowable.

The initial burden is on the examiner to establish a *prima facie* case that the claimed invention lacks utility. To properly reject a claimed invention under 35 U.S.C. 101, the Office must (A) make a *prima facie* showing that the claimed invention lacks utility, and (B) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing. *In re Gaubert*, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975). The *prima facie* showing must contain the following elements: (A) An explanation that clearly sets forth the reasoning used in concluding that the asserted utility for the claimed invention is neither both specific and substantial nor well-established; (B) Support for factual findings relied upon in reaching this conclusion; and (C) An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.

The examiner has failed to fulfill the initial burden. The examiner has failed to clearly sets forth the reasoning used in concluding that the asserted utility for the claimed invention is neither both specific and substantial nor well-established. The examiner makes an unsupported statement that “claim 8 and 27 provide evidence that claims 1 and 24 constitute a disembodied algorithm”. This statement clearly does not show the reasoning used in concluding that the asserted utility for the claimed invention is neither both specific and substantial nor well-established. Furthermore the examiner has not provided any factual support relied upon in reaching this conclusion. Therefore the examiner must withdraw the 35 U.S.C. § 101 rejection.

The examiner states that claim 8 and 27 provide evidence that claims 1 and 24 constitute a disembodied algorithm. Claims define nonstatutory processes if they: consist solely of mathematical operations without some claimed practical application (i.e., executing a "mathematical algorithm"); or simply manipulate abstract ideas, e.g., a bid (*Schrader*, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (*Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759), without some claimed practical application. It is not clear why the examiner believes that claims 8 and 27 provide evidence that claims 1 and 24 constitute a disembodied

algorithm. Claim 1, as discussed above, clearly does more than manipulate abstract ideas and clearly consist of more than just mathematical operations. Claim 1 is a method for operating an SCP. One of the main functions of an SCP is to receive call-setup messages and determine the proper routing for the call. The SCP in claim 1 fulfills this function in a new way. Clearly claim 1 and 24 have a practical application and are therefore allowable.

Claims 3 – 7 depend from allowable claim 1 and are therefore allowable.

Claim 24 is a method of operating a first wireless device where an alert message indicating an incoming call and caller information is received from an SCP. When it is determined that the incoming call should be sent to a second device, a response message is sent to the SCP indicating that the incoming call should be sent to a second device. Allowing a first device to send information to an SCP such that the call will be redirected from the first device to a second device provides a useful, tangible and concrete result. Allowing the user of a wireless device to send information to an SCP such that a call to the wireless device is re-directed to another device provides some immediate benefit to the public. Therefore claim 24 is allowable.

As discussed above, the initial burden is on the examiner to establish a *prima facie* case. Again, the examiner has not fulfilled this burden for claim 24. The examiner has failed to clearly set forth the reasoning used in concluding that the asserted utility for the claimed invention is neither both specific and substantial nor well-established. The examiner made an unsupported statement that “claim 8 and 27 provide evidence that claims 1 and 24 constitute a disembodied algorithm”. This statement clearly does not show the reasoning used in concluding that the asserted utility for the claimed invention is neither both specific and substantial nor well-established. Furthermore the examiner has not provided any factual support relied upon in reaching this conclusion. Therefore the examiner must withdraw the 35 U.S.C. § 101 rejection.

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Claims 25 and 26 depend from allowable claim 24 and are therefore allowable.

Claim Rejections under 37 CFR 1.75(c)

Claims 3, 10 and 17 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The claims depend on canceled claims. Claims 3, 10 and 17 have been amended to correct the improper dependencies.

Claim Rejections under 35 U.S.C. § 103

Claims 1, 3, 5 and 24-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,325,419 to Connolly et al. (hereinafter “Connolly”) in view of U.S. Patent Application No. 2002/0006811 to Diebolt et al. (hereinafter “Diebolt”). (Page 2 of the Office action.) Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Connolly and Diebolt in view of U.S. Patent No. 5,499,290 to Koster (hereinafter “Koster”). (Page 5 of the Office action.) Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Connolly and Diebolt in view of U.S. Patent No. 5,511,111 to Serbetcioglu et al. (hereinafter “Serbetcioglu”). (Page 5 of the Office action.) Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Connolly and Diebolt in view of U.S. Patent No. 6,590,965 to Poole et al. (hereinafter “Poole”). (Page 6 of the Office action.) Also, claims 8, 10, 12, 15, 17, 19 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Connolly and Diebolt in view of U.S. Patent No. 6,563,788 to Torba et al. (hereinafter “Torba”). (Page 7 of the Office action.) Claims 11 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Connolly, Diebolt and Torba in view of Koster. (Page 12 of the Office action.) Claims 13 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Connolly, Diebolt and

Torba in view of Serbetcioglu. (Page 12 of the Office action.) Claims 14 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Connolly, Diebolt and Torba in view of Poole. (Page 13 of the Office action.) Claims 27-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Connolly and Diebolt in view of Poole in view of U.S. Patent No. 6,643,506 to Criss et al. (Page 14 of the Office action.) Finally, claims 30-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Connolly and Diebolt in view of U.S. Patent No. 6,061,570 to Janow. (Page 17 of the Office action.) The Assignee respectfully traverses the rejections in view of the following discussion.

Claims 1, 8 and 15

Claims 1, 8 and 15 are directed to, respectively, a method of operating a service control point, a software product for operating a service control point, and a communication system comprising a service control point. In part, claim 1 provides for “receiving a response message into the service control point from the first device wherein the response message indicates a second device to receive the incoming call,” and “processing the response message to generate a routing instruction that connects the incoming call to the second device.” Claims 8 and 15 provide similar limitations.

With respect to claims 1, 8 and 15, the Office action indicates that “Connolly fails to clearly disclose wherein the said first device re-routes the incoming message to the second device.” (Page 3 of the Office action.) In response, the Assignee wishes to clarify the content of claims 1, 8 and 15. While the incoming call is routed to the second device instead of the first device, the first device does not perform this routing. Instead, this task is initiated in claims 1, 8 and 15 by way of the service control point transmitting a routing instruction, such as to a switch that performs the actual routing. This routing instruction is generated by processing a response message from the first device. As a result, the provision of the first device rerouting an incoming message to the second device, as described in the Office action, is not positively recited in the claims. Instead, the first device receives an alert message indicating the incoming call and caller information, and returns a response message to the service control point indicating a second device to receive the incoming call.

The Office action further asserts that “Diebolt et al. teaches in paragraph[s] [0017 – 0019] wherein the calling party is able to send a process command, which reads on claimed ‘alert message,’ that re-directs the incoming call to either a fax machine or printer, which reads on

claimed ‘second device.’” (Page 3 of the Office action.) The Assignee respectfully disagrees with this assertion in several ways. First, Diebolt indicates that a user with a wireless telecommunications device, and not necessarily a “calling party,” generates the process command. (Paragraph [0017].) Also, the alert message of claims 1, 8 and 15 is generated from a call set-up message and transmitted by the *service control point*, not a calling party. Further, the alert message indicates the incoming call and caller information to the first device, and does not redirect an incoming call. Thus, the Assignee contends that Diebolt does not teach or suggest the alert message of claims 1, 8 and 15, and such indication is respectfully requested.

The Assignee respectfully notes that some of the provisions of claim 1, such as the reception and processing of the response message from the first device, are not specifically addressed in the Office action. This omission may have resulted from an apparent accidental deletion of material at the end of the second paragraph of page 3 of the Office action.

Thus, based on the foregoing, the Assignee asserts that no combination of Connelly and Diebolt teaches or suggests the subject matter of claims 1, 8 and 15, and such indication is respectfully requested.

Claims 24, 27 and 30

Claims 24, 27 and 30 are directed to, respectively, a method of operating a first wireless device, a software product for a wireless communication device, and a wireless communication device. In part, claim 24 provides for “determining the incoming call should be sent to a second device; generating a response message indicating the second device is to receive the incoming call; and transmitting the response message from the first device to the service control point.” Claims 27 and 30 incorporate similar provisions.

With respect to claims 24, 27 and 30, the Office action indicates that “Connolly et al. fails to clearly disclose wherein the process of sending an alert message to a said second device.” (Page 3 of the Office action.) In response, the Assignee respectfully notes that the first device of claims 24, 27 and 40 does *not* send an alert message to the second device, but instead receives and processes the alert message, determines the incoming call should be sent to a second device instead, and generates and transmits a response message indicating the second device to the service control point.

Also, the Office action apparently attempts to equate the Diebolt process command with

the response message transmitted by the first device to the service control point. (Page 4 of the Office action.) Again, the Assignee respectfully disagrees. Generally, the Diebolt process command is transferred from a wireless telecommunications device by way of a private branch exchange (PBX) *to a nearby terminal*, such as a printer, fax machine, or computer-driven monitor of a data network. (Paragraph [0017].) In the examples discussed in Diebolt, the process command may be “a print or a view command of *some message* (email, fax) respectively on a printer or a monitor connected to the data network 5.” (Paragraph [0017]; emphasis supplied.)

Thus, the Diebolt process command is distinguished from the response message of claims 24, 27 and 30 in several ways. First, Diebolt does not indicate that these messages are in response to *an incoming call* directed to the wireless communication device, as provided for in claims 24, 27 and 30. Instead, these messages (such as e-mail or fax) are apparently *already stored* on the data network, to be accessed by the wireless communication device at a later time. In other words, these e-mail or fax messages have already been received, and the process command allows the user access to access them after the fact. For example, a process command may be directed to a printer, which executes the command to provide “a print of the *selected data*.” (Paragraph [0019]; emphasis supplied.) Thus, Diebolt does not teach or suggest the generation and transmission of a response message indicating a second device *to receive the incoming call*, as provided for in claims 24, 27 and 30.

Further, the Diebolt process command is directed through a PBX *to a terminal device*, such as a printer or monitor, which executes the process command. (Paragraph [0017].) Thus, Diebolt does not teach or suggest transmitting the response message to a service control point, as shown in claims 24, 27 and 30.

In another example, Diebolt discusses the ability of a wireless communications device to generate a process command for the *automatic transfer* of a call to a nearby fixed telephone. (Paragraph [0021].) Diebolt indicates that such a command would be advantageous if the battery of the wireless device has become depleted. (Id.) This particular process command is also distinguished from the response message of claims 24, 27 and 30 in a couple of ways. In this case, the process command is transferred to a computer coupling the PBX and fixed telephone network (paragraph [0021]), not to a service control point.

Further, the process command apparently does not include an indication of the second

device to receive an incoming call, as the call is transferred *automatically* to a fixed telephone within the same cell in which the wireless communications device is located. (Paragraph [0021].) In other words, the wireless device in Diebolt does not specify the fixed telephone to which the call is to be transferred, unlike claims 24, 27 and 30, in which the response message indicates the second device to receive the incoming call.

In addition, Diebolt discusses *transferring* a call from the wireless device to the fixed telephone, such as by way of a “hand over.” (Paragraph [0021].) In other words, the call has already been completed to the wireless device, and is then transferred to the fixed telephone. Thus, Diebolt does not teach or suggest generating a response message indicating the second device is to *receive the incoming call*, as provided for in claims 24, 27 and 30.

Thus, based on the foregoing, the Assignee asserts that no combination of Connelly and Diebolt teaches or suggests the subject matter of claims 24, 27 and 30, and such indication is respectfully requested.

Claims 3-7, 10-14, 17-21, 23, 25, 26, 28, 29, 31 and 32

Claims 3-7 depend from independent claim 1, claims 10-14 depend from independent claim 8, claims 17-21 and 23 depend from independent claim 15, claims 25 and 26 depend from independent claim 24, claims 28 and 29 depend from independent claim 27, and claims 31 and 32 depend from independent claim 30. Thus, each of these claims incorporates the subject matter of its associated independent claim, and thus is allowable for at least the reasons provided above in support of claims 1, 8, 15, 24, 27 and 30, and such indication is respectfully requested.

Thus, in light of the foregoing, the Assignee respectfully requests that the 35 U.S.C. § 103 rejections of claims 1, 3-8, 10-15, 17-21 and 23-32 be withdrawn.

Response to Arguments section

The examiner states that the claims do not disclose that the alert message is generated from a call setup message (page 20 of the Office action.). Claim 1 clearly states that a call setup message is received. Claim 1 also requires generating an alert message indicating the incoming call and caller information from the call set-up message. (underline added). This clearly indicates that the alert message is generated from the call setup message.

Conclusion

Based on the above remarks, the Assignee submits that claims 1, 3-8, 10-15, 17-21 and 23-32 are allowable. Additional reasons in support of patentability exist, but such reasons are omitted in the interests of clarity and brevity. The Assignee thus respectfully requests allowance of claims 1, 3-8, 10-15, 17-21 and 23-32.

The Assignee believes no fees are due with respect to this filing. However, should the Office determine additional fees are necessary, the Office is hereby authorized to charge Deposit Account No. 21-0765.

Respectfully submitted,

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SIGNATURE OF PRACTITIONER

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